

REOCT/PTO

9 DEC 2002

EV 262961729 US

Matter No. 6794S-000005USC
Express Mail No. EV 262961729 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 12 2003

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In re Application of Kararli, et al

Application No. 10/031,898

Group Art Unit:

I. A. Filed: December 6, 2000

For: Cyclooxygenase-2 Inhibitor Compositions
Having Rapid Onset of Therapeutic Effect

December 9, 2002

BOX MISSING PARTS
Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO NOTICE TO FILE MISSING PARTS

Sir:

In response to the Notice to File Missing Parts, dated May 7, 2002, Applicants submit the following:

1. Petition Under 37 C.F.R. §1.47(a);
2. Declaration in Support of Petition Under 37 C.F.R. §1.47(a);
3. Copy of Notice to File Missing Parts;
4. Declarations and Powers of Attorney;
5. Check for late filing fee and extension fee in the amount of \$2,090.00

Respectfully submitted,

By: Donald R. Holland
Donald R. Holland
Reg. No. 35,197
Harness, Dickey & Pierce
7700 Bonhomme, Suite 400
St. Louis, MO 63105
(314) 726-7500
(314) 726-7501 FAX



UNITED STATES PATENT AND TRADEMARK OFFICE

FAXED

MAY 14 2002

 Commissioner for Patents, Box PCT
 United States Patent and Trademark Office
 Washington, D.C. 20231
 www.uspto.gov

| U.S. APPLICATION NUMBER NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|-----------------------------|-----------------------|------------------|
| 10/031,898 | Kararli | 6794S-000005USC |

Donald R Holland
 Harness Dickey & Pierce
 7700 Bonhomme
 Suite 400
 St Louis, MO 63105

R E C E I V E D
 MAY 13 2002

HARNESS, DICKEY & PIERCE
 ST. LOUIS, MISSOURI

INTERNATIONAL APPLICATION NO.

PCT/US00/32434

I.A. FILING DATE

12/06/2000

PRIORITY DATE

12/09/1999

CONFIRMATION NO. 8229
 371 FORMALITIES LETTER



OC000000008015458

Date Mailed: 05/07/2002

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated Office (37 CFR 1.494):

- U.S. Basic National Fees
- Priority Document
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Preliminary Amendments

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- \$130 Surcharge for providing the oath or declaration later than the appropriate 20 months months from the priority date (37 CFR 1.492(e)) is required.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

SUMMARY OF FEES DUE:

Total additional fees required for this application is \$130 for a Large Entity:

- **\$130 Late oath or declaration Surcharge.**

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

SHELBY J VIGIL

Telephone: (703) 305-3653

PART 1 - ATTORNEY/APPLICANT COPY

| U.S. APPLICATION NUMBER NO. | INTERNATIONAL APPLICATION NO. | ATTY. DOCKET NO. |
|-----------------------------|-------------------------------|------------------|
| 10/031,898 | PCT/US00/32434 | 6794S-000005USC |

FORM PCT/DO/EO/905 (371 Formalities Notice)

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HDP/SB/21 based on PTO/SB/21 (08-00)

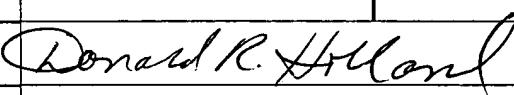
Please type a plus sign (+) inside the box → +

DT05 RECEIVED/PTO 09 DEC 2002

| | | | |
|--|--|------------------------|-------------------------|
| TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i> | | Application Number | 10/031,898 |
| | | Filing Date | December 6, 2002 (A.M.) |
| | | First Named Inventor | Kararli et al. |
| | | Group Art Unit | unknown |
| | | Examiner Name | unknown |
| Total Number of Pages in This Submission | | Attorney Docket Number | 6794S-000005/USC |

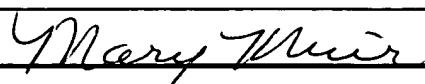
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MARCH 12 2003
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| ENCLOSURES (check all that apply) | | | |
|--|---|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input checked="" type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers <i>(for an Application)</i> <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition (1.47) <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | | |
| | <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i> Postcard Declaration & Power of Attorney Declaration in Support of Petition | | |
| | Remarks <div style="border: 1px solid black; padding: 5px; height: 40px; width: 100%;"></div> | | |
| | The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed. | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | | |
|--|---|--|--|
| Firm or Individual name | Harness, Dickey & Pierce, P.L.C. | | Attorney Name Donald R. Holland Reg. No. 35,197 |
| Signature |  | | |
| Date | December 9, 2002 | | |

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.

| | |
|-----------------------|---|
| Typed or printed name | Mary Muir |
| Signature |  |
| Date | 12/09/2002 |

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$ 2090)

| | |
|----------------------|--------------------------|
| Complete if Known | |
| Application Number | 10/031,898 |
| Filing Date | December 6, 2000 (I. A.) |
| First Named Inventor | Karari et al. |
| Examiner Name | unknown |
| Group / Art Unit | unknown |
| Attorney Docket No. | 6794S-000005/USC |

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1600 1600

METHOD OF PAYMENT (check one)

1. The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit Account Number

08-0750

Deposit Account Name

Harness, Dickey & Pierce, P.L.C.

Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17
 Applicant claims small entity status. See 37 CFR 1.27

2. Payment Enclosed:

Check Credit card Money Order Other

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity Fee Code | Fee (\$) | Small Entity Fee Code | Fee (\$) | Fee Description | Fee Paid |
|-----------------------|----------|-----------------------|----------|------------------------|----------|
| 101 | 740 | 201 | 370 | Utility filing fee | |
| 106 | 330 | 206 | 165 | Design filing fee | |
| 107 | 510 | 207 | 255 | Plant filing fee | |
| 108 | 740 | 208 | 370 | Reissue filing fee | |
| 114 | 160 | 214 | 80 | Provisional filing fee | |
| SUBTOTAL (1) | | | | | (\$ 0) |

2. EXTRA CLAIM FEES

| Total Claims | Independent Claims | Multiple Dependent | Extra Claims | Fee from below | Fee Paid |
|--------------|--------------------|--------------------|--------------|----------------|----------|
| | | | 0 | X | 0 |
| | | | 0 | X | 0 |

| Large Entity Fee Code | Fee (\$) | Small Entity Fee Code | Fee (\$) | Fee Description |
|-----------------------|----------|-----------------------|----------|--|
| 103 | 18 | 203 | 9 | Claims in excess of 20 |
| 102 | 84 | 202 | 42 | Independent claims in excess of 3 |
| 104 | 280 | 204 | 140 | Multiple dependent claim, if not paid |
| 109 | 84 | 209 | 42 | ** Reissue independent claims over original patent |
| 110 | 18 | 210 | 9 | ** Reissue claims in excess of 20 and over original patent |

FREYS 00000056 10031898 SUBTOTAL (2) (\$ 0)

1960.00 0P
**or number previously paid, if greater; For Reissues, see above

3. ADDITIONAL FEES

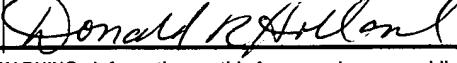
| Large Entity Fee Code | Fee (\$) | Small Entity Fee Code | Fee (\$) | Fee Description | Fee Paid |
|-----------------------|----------|-----------------------|----------|--|----------|
| 105 | 130 | 205 | 65 | Surcharge - late filing fee or oath | 130 |
| 127 | 50 | 227 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 139 | 130 | 139 | 130 | Non-English specification | |
| 147 | 2,520 | 147 | 2,520 | For filing a request for reexamination | |
| 112 | 920* | 112 | 920* | Requesting publication of SIR prior to Examiner action | |
| 113 | 1,840* | 113 | 1,840* | Requesting publication of SIR after Examiner action | |
| 115 | 110 | 215 | 55 | Extension for reply within first month | |
| 116 | 400 | 216 | 200 | Extension for reply within second month | |
| 117 | 920 | 217 | 460 | Extension for reply within third month | |
| 118 | 1,440 | 218 | 720 | Extension for reply within fourth month | |
| 128 | 1,960 | 228 | 980 | Extension for reply within fifth month | 1960 |
| 119 | 320 | 219 | 160 | Notice of Appeal | |
| 120 | 320 | 220 | 160 | Filing a brief in support of an appeal | |
| 121 | 280 | 221 | 140 | Request for oral hearing | |
| 138 | 1,510 | 138 | 1,510 | Petition to institute a public use proceeding | |
| 140 | 110 | 240 | 55 | Petition to revive – unavoidable | |
| 141 | 1,280 | 241 | 640 | Petition to revive – unintentional | |
| 142 | 1,280 | 242 | 640 | Utility issue fee (or reissue) | |
| 143 | 460 | 243 | 230 | Design issue fee | |
| 144 | 620 | 244 | 310 | Plant issue fee | |
| 122 | 130 | 122 | 130 | Petitions to the Commissioner | |
| 123 | 50 | 123 | 50 | Processing fee under 37 CFR 1.17 (q) | |
| 126 | 180 | 126 | 180 | Submission of Information Disclosure Stmt | |
| 581 | 40 | 581 | 40 | Recording each patent assignment per property (times number of properties) | |
| 146 | 740 | 246 | 370 | Filing a submission after final rejection (37 CFR § 1.129(a)) | |
| 149 | 740 | 249 | 370 | For each additional invention to be examined (37 CFR § 1.129(b)) | |
| 179 | 740 | 279 | 370 | Request for Continued Examination (RCE) | |
| 169 | 900 | 169 | 900 | Request for expedited examination of a design application | |

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$ 2090)

| | | | | | |
|-------------------|---|----------------------------------|--------|-----------|------------------|
| SUBMITTED BY | | Complete (if applicable) | | | |
| Name (Print/Type) | Donald R. Holland | Registration No. Attorney/Agent) | 35,197 | Telephone | 314-726-6500 |
| Signature |  | | | Date | December 9, 2002 |

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

EV 262961729 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Kararli, et al :
Application No. 10/031,898 : Group Art Unit: Unknown
I. A. Filed: December 6, 2000 :
For: Cyclooxygenase-2 Inhibitor Compositions :
Having Rapid Onset of Therapeutic Effect :

Commissioner for Patents
Washington, D.C. 20231

Sir:

PETITION UNDER 37 C.F.R. §1.47(a)

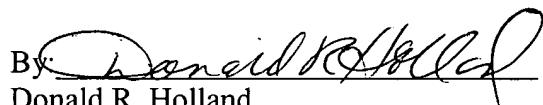
This is submitted as a petition under 37 C.F.R. 1.47(a) requesting that the above-identified application for patent be made by joint inventors signing the enclosed declarations on behalf of themselves and on behalf of a nonsigning inventor, Subhash Desai, Ph.D., who refuses to join in the application. The enclosed declaration is signed by all the available joint inventors with the signature block of the nonsigning inventor left blank which is treated as having been signed by all available joint inventors on behalf of the nonsigning inventor as set forth in M.P.E.P. § 409.3(a)(A). The pertinent facts are as set forth in the accompanying Declaration in Support of Petition by Mr. Steven J. Sarussi and the last know address of the nonsigning inventor, Subhash Desai, Ph.D., is 1011 Greenwood Avenue, Wilmette, Illinois, 60091.

The facts, in pertinent part as set forth in the Declaration by Steven J. Sarussi, are as follows. A copy of U.S. Application Serial No. 10/031,898 naming Subhash Desai, Ph.D as one of the joint inventors was provided to Dr. Desai on August 28, 2002 with a letter requesting that Dr. Desai execute the Declaration. Dr. Desai raised questions in a letter dated November 3, 2002 regarding his perceived entitlement to payment for reviewing patent applications and regarding why certain individuals were not listed as

inventors on the application. These questions were addressed in an oral voicemail message to Dr. Desai from Steven J. Sarussi on November 6, 2002. A further certified letter was sent on November 20, 2002 including all documents previously sent and requesting that Dr. Desai execute the declaration. Dr. Desai has refused and continues to refuse to execute the declaration.

It is, hereby, requested that the signing of the enclosed Declaration by all available joint inventors be accepted as execution on behalf of the nonsigning inventor Subhash Desai, Ph.D.

Respectfully submitted,

By 
Donald R. Holland
Reg. No. 35,197
Harness, Dickey & Pierce
7700 Bonhomme, Suite 400
St. Louis, MO 63105
(314) 726-7500
(314) 726-7501 FAX

12-10-03

262961729 PCT US

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Matter No. 6744S-000005USC

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Kararli, et al

Application No. 10/031,898

Group Art Unit:

I. A. Filed: December 6, 2000

For: Cyclooxygenase-2 Inhibitor Compositions
Having Rapid Onset of Therapeutic Effect

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1. Check in the amount of \$2,090.00
2. Transmittal Form;
3. Fee Transmittal Letter (in duplicate);
4. Response to Notice to File Missing Parts;
5. Copy of Declaration and Power of Attorney;
6. Return Postcard.

By Donald R. Holland
Donald R. Holland, Reg. No. 35,197
Harness, Dickey & Pierce, P.L.C.
7700 Bonhomme, Suite 400
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